

REMARKS

Claims 1-3, 5-9, 16, 17 and 19-35 are pending in the subject application. All of claims 1-3, 5-9, 16, 17 and 19-33 have been examined on the merits in their present form: claims 1-3 and 5-9 are allowed; claim 23 has been indicated as containing allowable subject matter; and claims 16, 17, 19-22 and 24-33 stand rejected. In the previously-submitted Amendment (filed on July 14, 2003 and now to be considered pursuant to the filing of an RCE), no claims were amended; however, new dependent claims 34 and 35 were added.

The Examiner now requires Applicant to elect one of three inventions defined by the Examiner as: Invention I to which claims 1-3 and 5-9 are drawn; Invention II to which claims 16 and 17 are drawn; and Invention III to which claims 19-35 are drawn. Applicant hereby elects with traverse "Invention III" as defined by the Examiner, to which claims 19-35 are presently drawn.

Applicant's reasons for traversal are as follows. Since this application has been assigned to a new Examiner, for the Examiner's benefit, Applicant provides a brief overview of the history of the prosecution, which sheds considerable light on the impropriety of the present restriction requirement. Prior to the first action on the merits, the original Examiner imposed a four-way restriction requirement on original claims 1-22, and Applicant elected without traverse what was then defined as "Invention I", which included claims 1-9 and 16-22. The Examiner stated that the subject matter of these claims was classified in class 709, subclass 224. All of the presently pending claims are directed to this "Invention I" as then defined (the record reflects that present independent claim 24 is essentially an amended version of original independent claim 18).

Curiously, in the next Office Action, the Examiner imposed an election of species requirement. Specifically, the Examiner found all of the pending claims to be generic, except dependent claims 5 and 6, which were found to be separate species (these claims had not been amended in any way). Applicant elected without traverse the species to which claim 5 was drawn, with the net effect that claims 1-5, 7-9 and 16-23 remained under consideration and only claim 6 was temporarily withdrawn from consideration.

In response to the first Office Action on the merits (the third Office Action overall), Applicant rewrote claim 1 to include the subject matter of allowable claim 4, thereby placing

Response to Restriction
U.S. Patent Appln. No. 09/256,647

claims 1-3 and 5-9 in condition for allowance. Applicant also made minor amendments to independent claim 16 and replaced independent claim 18 with new independent claim 24, directed to the same general subject matter.

In the subsequent Office Action, which was made final, the Examiner confirmed allowance of claims 1-3 and 5-9 and indicated that dependent claim 23 was allowable, but maintained the rejection of the remaining claims. Both independent claims 16 and 24 were rejected over the same primary reference. In response, Applicant submitted an Amendment in which the rejections were traversed and none of the pending and previously-considered claims was amended. Only two minor dependent claims were added by this Amendment. In response to the subsequent Advisory Action, Applicant filed a Request for Continued Examination (RCE) in the reasonable expectation that claims 1-3 and 5-9 would remain allowed (and claim 23 allowable), new dependent claims 34 and 35 would be considered, and prosecution would move forward on independent claims 16 and 24 with consideration of Applicant's rebuttal arguments.

However, despite the fact that all but two minor dependent claims have been repeatedly searched and examined, despite the fact that none of these claims was amended in previously-submitted Amendment, despite the fact that one set of claims stands allowed, and despite the fact that all of the remaining claims stand rejected over the same primary reference, the Examiner now imposes a three-way restriction requirement! While Applicant understands that the rules do not explicitly prevent an Examiner from repeatedly imposing restriction or election of species requirements during prosecution of an application (e.g., there have been three separate such actions in this application alone), given the present state of the prosecution, the present restriction requirement is unreasonable. There is no prohibition or policy against claiming multiple inventions in a single application. Restriction practice exists to prevent undue burden on Examiners by avoiding multiple, unrelated searches and corresponding prosecution. In the present case, all of the pending claims have been searched and repeatedly considered. Presumably, the new Examiner can and should pick up where the previous Examiner left off, with the benefit of the prior searches and the prosecution that has been developed to date.

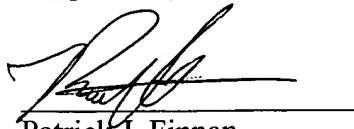
While Applicant appreciates that the Examiner may have a different view of the claims and prior art than the previous Examiner, Applicant should not be penalized procedurally at this point in the prosecution simply because the Patent and Trademark Office decided to reassign this

Response to Restriction
U.S. Patent Appln. No. 09/256,647

application. At a minimum, the Examiner should fully consider the existing prosecution history and the standing of the claims before jumping to the conclusion that a three-way restriction is appropriate at this point. For example, how can it be reasonably argued that claims 1-3 and 5-9 place any burden on the Examiner at all, when these claims have already been allowed? Further, if it is really the case that claims 16 and 24 (Inventions II and III, respectively) are so drastically different that they require consideration in separate applications, how is it that these two independent claims currently stand rejected over the very same primary reference? Without first considering the prosecution history, how can the Examiner know that the previous Examiner was so utterly wrong in concluding that these claims were directed to a common invention (as evidenced by the current rejections) and that it would be appropriate to simply discard the considerable prosecution history of two of the three independent claims at this late point in the prosecution? Applicant respectfully requests the Examiner to fully consider the prosecution history to date and to reconsider and withdraw the restriction requirement in view of the relevant facts, as outlined above.

Filed concurrently herewith is a Petition for an Extension of Time of one month (small entity). Applicant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 05-0460.

Respectfully submitted,

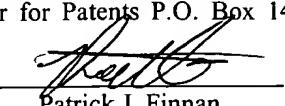


Patrick J. Finn
Registration No. 39,189

EDELL, SHAPIRO & FINNAN, LLC
1901 Research Boulevard, Suite 400
Rockville, Maryland 20850-3164
(301) 424-3640

Sent Via First Class Mail on: January 5, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents P.O. Box 1450, Alexandria, Virginia 22313-1450 on January 5, 2004 by Patrick J. Finn.



Patrick J. Finn